REMARKS

Claims 1, 3 to 23, 28, 29 and 32 remain pending. Claims 1, 4, 5, 8, 9, 12, 15, 21, 29 and 32 have been amended to more clearly recite that the respective measurements are obtained with an ultrasound machine. No claims are added or canceled and no new matter is added.

Entry of the foregoing amendments is respectfully requested after final because the amendments either overcome the pending rejection and place the claims in condition for allowance, or more clearly define the issues for appeal. Since the change in claim language is primarily one of semantics (e.g., replacing "ultrasonographically measuring" to "measuring… utilizing an ultrasound machine"), no new search or consideration is needed.

The only outstanding rejection is under 35 U.S.C. § 101. In the Action dated December 31, 2008, the Office asserted that the rejection was maintained because:

(1) "applicant has not positively recited another statutory class of invention in that an ultrasound machine is not positively recited;" and

(2) "method steps 2 and 3 are not tied to tied to any other statutory class of invention and are further not carried out by the implied ultrasound of step 1."

Applicants respectfully submit that the amendments submitted herewith resolve both of these issues. In particular, the first step of claim 1 has been amended to explicitly recite the step of measuring the width of the ventricular septal wall of said racehorse candidate utilizing an ultrasound machine. Steps 2 and 3 are amended to further recite that the measurements for the group of horses are also "ultrasonographically-obtained" measurements.

Accordingly, Applicants respectfully submit that the method set forth in claim 1, and in all of the dependent claims that follow, is explicitly tied to a machine – more specifically an ultrasound machine.[1]

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[1] As the Office and one of ordinary skill in the art will readily understand, ultrasonographically obtained measurements can only be obtained by using an ultrasound machine, *i.e.*, a machine that produces and receives ultrasound energy.

To the extent that the Office would argue that other steps of claim 1, or any of the dependent claims do NOT explicitly recite a machine, Applicants respectfully note that the Court of Appeals for the Federal Circuit, in the recent *In re Bilski* decision made clear that it is inappropriate to determine the patent eligibility of a claim as a whole based on whether selected limitations constitute patentable subject matter, and that "it is irrelevant that any individual step or limitation of [the claimed process] by itself would be unpatentable under § 101." *In re Bilski*, slip opinion at 17-18 (Fed. Cir. 2008). So long as a process claim is shown to be tied to a particular machine, or transforms an article, it satisfies Section 101. *Id.*, slip opinion at 24.

CONCLUSION

In view of the foregoing, Applicants respectfully request withdrawal of the pending rejection under Section 101 and request a Notice of Allowability for all of pending claims 1 to 23, 28, 29 and 32.

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